

REMARKS

Claims 1 through 19 were pending in this Application, of which claims 6, 7 and 19 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1 through 5 and 8-11 and 13-18 are active.

Claims 1 through 3 and 11 through 13 have been amended and claim 12 has been cancelled. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure noting, for example, paragraphs [0032] through [0038] and paragraph [0048]. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 12 and 13 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner asserted that the claims are indefinite in failing to point out what is included or excluded. This rejection is traversed.

Claims 12 and 13 were separately rejected under the second paragraph of 35 U.S.C. § 112.

In this statement of the rejection the Examiner asserted that there is no positive recitation of the possible codopants that are not Al₂O₃. This rejection is also traversed.

Claim 12 has been cancelled and, therefore, the rejection is moot.

As to each of the above rejections under the second paragraph of 35 U.S.C. § 112, Applicants would stress that indefiniteness under the second paragraph of 35 U.S.C. § 112 is a **question of law**. *Personalized Media Communications LLC v. U.S. International Trade*

Commission, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998); *Tillotson, Ltd v. Wlaboro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the Examiner must provide a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope of protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Significantly, consistent judicial precedents holds that **reasonable precision** in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Zoltek Corp. v. United States*, 48 Fed. Cl. 240, 57 USPQ2d 1257 (Fed. Cl. 2000); *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc., v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *U.S. v. Teletronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ (Fed. Cir. 1986). Applicants stress that claims must be interpreted as one having ordinary skill in the art would have interpreted the claims in light of and consistent with the supporting specification. *Zoltek Corp. v. United States*, *supra*; *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

Applicants would further point out that a claim can only be held indefinite if reasonable efforts at claim interpretation prove futile, and that the claim is insolubly ambiguous with no narrowing construction proper regardless of how formable a task it is to understand the claim. *Exxon Research & Eng'g., Co. v. United States*, 265 F.3d 1371, 1375 [60 USPQ2d 1272] (Fed. Cir. 2001). See also *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, ____ F.3d ____, 76 USPQ2d 1741 (Fed. Cir. 2005).

In applying the above legal tenets to the exigencies of the case, Applicants submit that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention under the second paragraph of 35 U.S.C. § 112. Specifically, as to the first basis for the rejection under the second paragraph of 35 U.S.C. § 112, the Examiner is basically asserting that the claims are broad. However, breadth is not synonymous with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971); *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970). Indeed, it is Applicants' right to claim what Applicants regard as their invention. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979); *In re Borkowski*, *supra*.

As to the second basis for the rejection on the second paragraph of 35 U.S.C. § 112, the Examiner asserted the inability to understand the possible codopant. Certainly claims are to be interpreted in light of and consistent with the written description of the specification in the **context** of the disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*). Clearly the functioning of codopants and their nature are disclosed.

At any rate, in order to expedite prosecution, claim 13 has been amended to clarify that the codopant is an oxide of an element adapted to become a trivalent positive ion, of course, excluding Al₂O₃, and that the Bi ion functions as a fluorescent dopant. Applicants submit that one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

Applicants, therefore, submit that the above rejection of claim 13 under the second paragraph of 35 U.S.C. § 112 is not legally viable and, hence, solicit withdrawal thereof.

Claims 1 through 5 and 8 through 16 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Kondo et al.

In the statement of the rejection the Examiner referred to, *inter alia*, composition B1 in Table 2, asserting the disclosure of a fluorescent glass corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In imposing a rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference identically discloses each and every feature of the claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are dramatic fundamental differences between the claimed fluorescent glass composition and the glass composition disclosed by Kondo et al. that scotch the factual determination that Kondo et al. disclose a fluorescent glass composition identically corresponding to that claimed.

Specifically, and even without the present Amendment, independent claim 1 specifies that the claimed fluorescent glass contains at least 50 mol% of at least one oxide selected from the group of SiO₂, GeO₂, and P₂O₅. It is not apparent wherein such a glass composition is disclosed by Kondo et al. Further, independent claim 1 specifies that Bi ion is the dopant. There is no Bi ion dopant in the glass composition disclosed by Kondo et al.

At any rate, in order to expedite prosecution, the present Amendment has been implemented to clarify that the recited SiO₂, GeO₂, and P₂O₅ component, which again must be present in at least 50 mol%, is the host glass, and that the Bi ion component is the fluorescent dopant. No such glass composition is disclosed or suggested by Kondo et al.

Indeed, the glass composition disclosed by Kondo et al. contains Bi₂O₃ as part of the host glass. Moreover, the dopant in the glass composition of Kondo et al. is Tm – not Bi ion.

The above argued dramatic fundamental differences between the claimed glass composition and the glass composition disclosed by Kondo et al. undermine the factual determination that Kondo et al. disclose a fluorescent glass composition identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 5 and 8 through 16 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kondo et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 17 and 18 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kondo et al. in view of Wysocki et al.

This rejection is traversed. Specifically, claims 17 and 18 ultimately depend upon independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kondo et al. The secondary reference to Wysocki et al. does not cure the previously argued deficiencies of Kondo et al. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants certainly do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 17 and 18 under 35 U.S.C. § 103 for obviousness predicated upon Kondo et al. in view of Wysocki et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Application No.: 10/725,928

Respectfully submitted,

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